

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 512797/bof	FOR FURTHER ACTION		See item 4 below
International application No. PCT/EP2015/000994	International filing date (<i>day/month/year</i>) 12 May 2015 (12.05.2015)	Priority date (<i>day/month/year</i>) 20 May 2014 (20.05.2014)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant GIESECKE & DEVRIENT GMBH			

<p>1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).</p> <p>2. This REPORT consists of a total of 9 sheets, including this cover sheet.</p> <p>In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.</p>																								
<p>3. This report contains indications relating to the following items:</p> <table border="0"> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table> <p>4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).</p>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input checked="" type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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	Date of issuance of this report 22 November 2016 (22.11.2016)
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PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**
(PCT Rule 43*bis*.1)

To:

see form PCT/ISA/220

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/EP2015/000994

International filing date (day/month/year)
12.05.2015

Priority date (day/month/year)
20.05.2014

International Patent Classification (IPC) or both national classification and IPC
INV. H04W12/04 H04W8/20 ADD. H04W4/00

Applicant
GIESECKE & DEVRIENT GMBH

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1*bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

Name and mailing address of the ISA:



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0
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Date of completion of this opinion

see form PCT/ISA/210

Authorized Officer

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Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of:
 - the international application in the language in which it was filed.
 - a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1 (b)).
2. This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of a sequence listing:
 - a. forming part of the international application as filed:
 - in the form of an Annex C/ST.25 text file.
 - on paper or in the form of an image file.
 - b. furnished together with the international application under PCT Rule 13ter.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file.
 - c. furnished subsequent to the international filing date for the purposes of international search only:
 - in the form of an Annex C/ST.25 text file (Rule 13ter.1(a)).
 - on paper or in the form of an image file (Rule 13ter.1(b) and Administrative Instructions, Section 713).
4. In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	<u>14</u>
	No: Claims	<u>1-13, 15, 16</u>
Inventive step (IS)	Yes: Claims	
	No: Claims	<u>1-16</u>
Industrial applicability (IA)	Yes: Claims	<u>1-16</u>
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1 Reference is made to the following documents;

D1 EP 2 693 784 A1 (GEMALTO SA [FR]) 5 February 2014 (2014-02-05)

D2 FR 2 945 143 A1 (BNP PARIBAS [FR]; CAISSE NATIONALE DES CAISSES D [FR]; CAISSE FEDERALE) 5 November 2010 (2010-11-05)

D3 EP 2 437 530 A1 (GIESECKE & DEVRIENT [DE]; ADVANCED RISC MACH LTD [GB]) 4 April 2012 (2012-04-04)

D4 US 2013/227137 A1 (DAMOLA AYODELE [SE] ET AL) 29 August 2013 (2013-08-29)

2 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of independent **claims claims 1, 7 and 15** is not novel in the sense of Article 33(2) PCT.

2.1 **D1** discloses all the features of **claim 1** (the references in brackets applying to this document):

A security element [cf. paragraph 0034: "...embedded UICC 14...token 14..." comprising a user subscription [cf. paragraph 0072: "The token memory 144 stores preferentially data, as service subscription data, relating to one or several subscriptions to the mobile radio-communication network(s) 16..." and paragraph 0090: "one or several ...SIM) type applications..."], and a second subscription [cf. paragraph 0074: "besides data relating to one or several subscriptions to the wireless service(s), the token memory 144 may store data relating to one or several subscriptions to a mobile TV service, a mobile payment service, a wallet service and/or other data relating to one or several subscriptions to other service(s)..."] and paragraph 0090: "and possibly (an) other application(s)..."], wherein

(1) the security element is arranged such that the service-provider subscription is employable in parallel to the user subscription [cf. paragraph 0074: "...Data relating to one subscription to one or several wireless services

includes:one or several applicative keys, like a key for accessing a user bank account through the mobile radio-communication network(s) 16...", note here that the authentication to access a user bank account is performed via mobile network 16, meaning in parallel to being authenticated via user subscription (i.e. sim app)"]

(b) the second subscription is a service-provider [cf. paragraph 0072: "mobile payment service"] subscription associated with a service provider [cf. paragraph 0074: "...Data relating to one subscription to one or several wireless services includes:one or several applicative keys, like a key for accessing a user bank account through the mobile radio-communication network(s) 16 and/or a key for accessing a user bank account over a short range RF link (not represented)..."]

(c) the service associated with the service provider becomes utilizable on the basis of the service-provider subscription [cf. paragraph 0074: "...Data relating to one subscription to one or several wireless services includes:one or several applicative keys, like a key for accessing a user bank account through the mobile radio-communication network(s) 16..."].

- 2.2 As a consequence, **claim 1** does not comply with the provisions set out in Article 33(2) PCT due to lack of novelty of its subject-matter.
- 2.3 Equally, **claim 7** does not comply with the provision of Article 33(2) PCT , because its subject-matter corresponds to that of **claim 1**, which is known from **D1** (cf. point 2.1).
- 2.4 **Claim 15 claim 7** does not comply with the provision of Article 33(2) PCT ,, because its subject-matter corresponds to that of **claim 1**, which is known from **D1** (cf. point 2.1) and the following additional feature is also known from **D1**:
- "utilizable on the basis of the service-provider subscription independently of the user subscription"

[cf. **D1**, paragraph 0074: "...Data relating to one subscription to one or several wireless services includes: ...one or several applicative keys, like ...a key for accessing a user bank account over a short range RF link (not represented)...", note here that access to a user bank account is done via short range RF link (i.e. NFC link), meaning independently from being authenticated to mobile network 16 via user subscription (i.e. sim app)]

3 Moreover, the subject-matter of the present **independent claims** is also not novel (Article 33(2) PCT) against the disclosure of document **D2** or **D3** (cf. the passages cited in the search report). Moreover the subject-matter of the **independent claim 1** is also not novel (Article 33(2) PCT) against the disclosure of document **D4**.

4 Additionally, the **dependent claims** do not contain any additional feature, which either alone or in combination with the feature of any claim to which they refer, to meet the requirement of PCT with respect to novelty (Article 33 (2) PCT) and/or inventive step ((Article 33(3) PCT), because those feature are either known from the above cited prior art (i.e. "the security element comprises different types of subscriptions that are treated in dependence on their type [cf. **D1**, paragraph 0091: "SIM application...USIM) application...CSIM) application...ISIM) application"],

"the secure element controls the number of subscriptions that can be activated concurrently [cf. **D1**, paragraph 0074: "Data relating to one subscription..to wireless services includes...a key for accessing a user bank account through the mobile radio-communication network(s) 16..."]",

"only one user subscription is activated at a given time [cf. **D1**, paragraph 0093: "SIM type application(s)...relating to the currently active first ...subscription..."]",

"activating service subscriptions concurrently [cf. **D2**, page 9, lines 25- 10, line 2: "l'activation de l'ensembles des applications de paiement...l'activation...de l'application de paiement locale 13a et de l'application de paiement international 13b..."]",

"the security element comprises a first application associated to a service-provider subscription and a second application associated to a user subscription [cf. **D1**, paragraph 0074: "...besides data relating to one or

several subscriptions to the wireless service(s), the token memory 144 may store data relating to one or several subscriptions to a mobile payment service, a wallet service..."] ,

"a subscription control application part of the operating system of the end device [cf. **D1**, paragraphs 0109-0101: "...To carry out such a criterion comparison and such an internal ...searching of one or several corresponding internal ...service subscription data sets...executes preferably an agent...the agent is supported by the phone 12..."],

"subscription control application communicates with an external subscription control server to received subscription control conditions [cf. **D1**, paragraph 0113: "...The agent allows sending, through the phone 12, to the server 18, a request for (down)loading data relating to one or several service subscriptions accompanied with the requested criterions...."]",

"subscription control application adjusts the subscription condition in dependence on the conditions received from subscription control server [cf. **D1**, paragraph 0088: "As first and/or third criterion(s), it may include: ...predefined maximum rate(s) for communicating data, a predefined cost(s) per consumption time unit..." and paragraph 0105: "...if only one criterion is requested and matches one criterion that is associated with one service subscription and stored within the token memory 144, then the token 14 deactivates a currently active service subscription and activates another resident service subscription that is associated with the corresponding criterion..."]",

"associating a client application with a subscription stored on a secure element [cf. **D1**, paragraphs 0100-0105: "...the criterion(s) that is(are) to be compared to the first reference criterion(s) may be requested by an application that is supported by the phone 12...if only one criterion is requested and matches one criterion that is associated with one service subscription and stored within the token memory 144, then the token 14 ...activates another resident service subscription that is associated with the corresponding criterion..."]",

"signing packets intended for a service provider [cf. **D1**, paragraph 0166: "...server 18 verifies a signature on the received signed data..."]",

"external subscription server controlling subscriptions using the subscription control application [cf. **D1**, paragraph 0113: "...The agent allows sending, through the phone 12, to the server 18, a request for (down)loading data relating to one or several service subscriptions accompanied with the requested criterions...."]")

or are common measures for the person skilled in the art (i.e. "signature of a packet includes a datum").

Re Item VII

Certain defects in the international application

- 1 The prior art documents cited above are not acknowledged in the description (Rule 5.1(a)(ii) PCT).